



UNITED STATES PATENT AND TRADEMARK OFFICE

71

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,590	03/13/2001	Kevin J. Dowling	CO1104/70016	1160

7590 06/17/2003

RICHARD F. GIUNTA
C/O WOLF, GREENFIELD & SACKS, P.C.
FEDERAL RESERVE PLAZA
600 ATLANTIC AVENUE
BOSTON, MA 02210-2211

EXAMINER

A, MINH D

ART UNIT PAPER NUMBER

2821

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/805,590

Applicant(s)

DOWLING ET AL.

Examiner

Minh D A

Art Unit

2821

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-103 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - Group 1. Claims 1-50, drawn to a display with LED, classified in class 345, subclass 46.
 - Group 2. Claims 1 and 51-68, drawn to a controller for a lighting device, classified in class 315, subclass 291.
 - Group 3. Claims 69-89, drawn to method of controlling power to LEDs, classified in class 362, subclass 800.
 - Group 4. Claims 69 and 90-103, drawn to a method of controlling power to LEDs using a memory stored program, classified in class 362, subclass 800.
- Claims 1 and 69 are linking claims (MPEP 809.03).

Claims [1 and 69] links inventions [1 and 2] and [3 and 4]; respectively. The restriction requirement between the linked invention is subject to the nonallowance of the linking claims, claims [1 and 69]. Upon the allowance of the linking claims, the restriction requirement as to the linked invention shall be withdrawn and any claims depending from or otherwise including all the limitations of the allowable linking claims will be entitled to examination in the instant application. Applicants are advised that if any such claims depending from or including all the limitations of the allowable linkings claims is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or

Art Unit: 2821

nonstatutory double patenting rejection over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. In re Ziegler, 44 F.2d 1211, 1212, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP 804.01.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions Group 1 and group 2 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

3. In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because claims 1-50 include limitations which may distinguish the recited device over the prior art without the additional limitations recited in the subcombination claims 51-68. Also, claims 1-50 recites numerous limitations which concern a display and this display does not need the controller or other elements recited in the subcombination to function properly. Other means than those recited in the subcombination can be used to control the device recited in claims 1-50.

Consequently, the subcombination is not required for the combination to be patentable.

4. The subcombination has separate utility such as being used to control other types of lighting devices. Claims 51-68 recite limitations concerning the functioning of computer code and signals outputted in response to the execution of this computer code. These limitations are not dependent on the elements recited in the combination

Art Unit: 2821

claims 1-50 for proper functioning. Another lighting device can be controlled with the computer code recited in claims 51-68; and as such, gives separate utility to the subcombination claims.

5. Inventions Group 3 and group 4 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

6. In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because this combination concern the steps for the operation of invention group 1; and since invention group 1 did not required the particulars of invention group 2, the method of operation of the invention group 1 does not required the particulars of the method of operation of invention group 2.

7. The subcombination has separate utility such as those discussed above for invention group 2.

8. Inventions group 1 and group 3 are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another materially different process.

Art Unit: 2821

9. Claims 52-89 of Invention group 3 recite steps in the form of computer code for controlling the device of Invention group 1. Code could be written and used to control the device of invention group 1 which would include different steps and still allow the device of invention group 1 to function properly. Actually, the device of invention group 1 could be controlled by any number of different processes, which output and monitor different signal and still function properly. Since the device of Invention group 1 can be used with such different processes, it is a distinct invention.

10. Inventions group 2 and group 3 are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be practiced by another materially different process. This is analogous to Invention group 1 and group 3, and the argument used for Inventions group 1 and group 3 also applies here for Inventions group 2 and group 4.

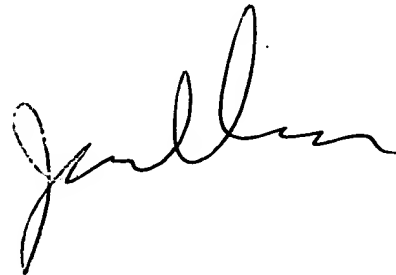
11. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

12. Because these inventions are distinct for the reason given above and the search required for each group is different, restriction for examination purposes as indicated is proper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Minh A whose telephone number is (703) 605-4247. The examiner can normally be reached on M-F (7:30 —4:30 PM).

If attempts to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Don Wong, can be reached on (703) 308-4856. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9318 for regular communications and (703) 872-9319 for final communications.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 308-0956.

A handwritten signature in black ink, appearing to read 'Minh A', is positioned to the right of the text block.

Examiner

Minh A

Art unit 2821

06/12/03